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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,300	07/30/2003	Wai Mun Lee	8317-194-999	9136

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EXAMINER	
DELCOTTO, GREGORY R	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/630,300	LEE, WAI MUN	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4/6/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are pending. Applicant's amendments and arguments filed 4/6/06 have been entered. Note that, the Examiner asserts that claims 1-20 all have various effective filing dates which are as follows:

Claims 1 and 2: 11/5/1990

Claims 3 and 7: 7/9/1992

Claims 4, 5, 6, 8, 9, 10, 11, 12, 13, 16, 19, and 20: 6/21/1993

Claims 14, 15, 17, and 18: 7/30/03 due to the presence of "about 2.5% to about 20% by weight neat hydroxylamine" in claim 13, "about 70% water" in claims 14 and 15, and the broad recitation of "organic acid" in claims 17 and 18.

Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 10/6/05 have been withdrawn:

The rejection of claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,825,156, claims 1-53 of US 6,564,812, claims 1-13 of US 6,399,551, claims 1-21 of US 6,367,486, claims 1-6 of US 6,276,372, claims 1-19 of US 6,000,411, claims 1-17 of US 5,911,835, and claims 1-11 of US 5,482,566 has been withdrawn due to the filing of a terminal disclaimer.

The rejection of claims 1-3, 5-8, 11-15, 19, and 20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15

of U.S. Patent No. 6,242,400 or claims 1-14 of US 5,381,807 has been withdrawn due to the filing a terminal disclaimer.

The rejection of claims 5 and 6 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ward (US 5,419,779), Lee (US 6,000,411), or Lee (US 5,672,577) has been withdrawn.

The rejection of claims 5, 6, 8-13, and 16 under 35 U.S.C. 102(b) as anticipated by Lee et al (US 5,911,835) has been withdrawn.

The rejection of claims 8-13, and 16 under 35 U.S.C. 102(b) as being anticipated by Ward (US 5,419,779), Lee (US 6,000,411), or Lee (US 5,672,577) has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 5,911,835), Lee (US 5,672,577), or Lee (US 6,000,411).

Ward teaches an aqueous stripping composition comprising a mixture of about 55% to 70% by weight of monoethanolamine, about 22.5 to 15% by weight of hydroxylamine, and water. The composition is suitable for stripping photoresists. See

Abstract. A corrosion inhibitor may be added to the composition in amounts up to 10% by weight an includes catechol or pyrogallol. See column 2, lines 40-65.

'411 teaches a composition for removing resists and etching residue from a substrate. See column 1, lines 15-30. The cleaning compositon for removing resist and etching residue contains from about 5% to 50% by weight of hydroxylamine, from about 10% to 80% by weight of an alkanolamine, from about 5% to 30% by weight of a chelating agent, and water. See column 6, lines 10-30. Examples of substrates from which the stripping and cleaning compositions remove resists include aluminum, titanium, etc. See column 8, lines 25-50.

'577 teaches a composition for removing resists and etching residue from a substrate. See column 1, lines 15-30. The cleaning composition for removing resist and etching residue contains from about 5% to 50% by weight of hydroxylamine, from about 10% to 80% by weight of an alkanolamine, from about 5% to 30% by weight of a chelating agent, and water. See column 6, lines 10-30. Examples of substrates from which the stripping and cleaning compositions remove resists include aluminum, titanium, etc. See column 8, lines 25-50.

However, '835, '577, or '411 do not teach, with sufficient specificity, removing a resist using a composition containing the specific amount of water or an organic acid as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to remove a resist using a composition containing the specific amount of water or an organic acid as recited by the instant claims, with a reasonable

expectation of success, because the broad teachings of '835, '577, or '411 suggest removing a resist using a composition containing the specific amount of water or an organic acid as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5, 7-10, 12-19, and 21-23 of copending Application No. 10/442858. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3-5, 7-10, 12-19, and 21-23 of 10/442858 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to remove a resist using a composition containing a hydroxylamine, alkanolamine, solvent, chelating agent, the specific amount of water or an organic acid as recited by the instant claims, with a reasonable expectation of

success, because claims 1, 3-5, 7-10, 12-19, and 21-23 of 10/442858 suggest removing a resist using a composition containing hydroxylamine, alkanolamine, solvent, chelating agent, specific amount of water or an organic acid as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Note that, with respect to claims 14 and 15 and claims 17 and 18, Applicant states that the limitation of "at least 70% by weight water" and "an organic acid", respectively, are fully supported through the continuity of parent applications and thus, the prior art is not applicable. In response, note that, the Examiner maintains that the limitations "at least 70% by weight water" and "an organic acid" are not supported back through the continuity of parent applications and thus, are not afforded a filing date any earlier than 7/30/03 which is the filing date of the instant application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD

June 26, 2006